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REQUEST FOR CONTINUED EXAMINATION (RCE) TRANSMITTAL

Subsection (b) of 35 U.S.C. § 132, effective on May 29, 2000,
provides for continued examination of an utility or plant application
filed on or after June 8, 1995.
See The American Inventors Protection Act of 1999 (AIPA).

| | |
|------------------------|-------------------|
| Application Number | 09/723,718 |
| Filing Date | November 28, 2000 |
| First Named Inventor | Gold |
| Group Art Unit | 1634 |
| Examiner Name | Zitomer, S. |
| Attorney Docket Number | NEX10-6 |

#10
CD

This is a Request for Continued Examination (RCE) under 37 C.F.R. § 1.114 of the above-identified application.

NOTE: 37 C.F.R. § 1.114 is effective on May 29, 2000. If the above-identified application was filed prior to May 29, 2000, applicant may wish to consider filing a continued prosecution application (CPA) under 37 C.F.R. § 1.53 (d) (PTO/SB/29) instead of a RCE to be eligible for the patent term adjustment provisions of the AIPA. See Changes to Application Examination and Provisional Application Practice, Final Rule, 65 Fed. Reg. 50092 (Aug. 16, 2000); Interim Rule, 65 Fed. Reg. 14865 (Mar. 20, 2000), 1233 Off. Gaz. Pat. Office 47 (Apr. 11, 2000), which established RCE practice.

1. Submission required under 37 C.F.R. § 1.114

- a. ☐ Previously submitted
 - i. ☐ Consider the amendment(s)/reply under 37 C.F.R. § 1.116 previously filed on _____
(Any unentered amendment(s) referred to above will be entered).
 - ii. ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on _____
 - iii. ☐ Other _____
- b. ☒ Enclosed
 - i. ☒ Amendment/Reply
 - ii. ☐ Affidavit(s)/Declaration(s)
 - iii. ☐ Information Disclosure Statement (IDS)
 - iv. ☐ Other _____

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2. Miscellaneous

- a. ☐ Suspension of action on the above-identified application is requested under 37 C.F.R. § 1.103(c) for a period of _____ months. (Period of suspension shall not exceed 3 months; Fee under 37 C.F.R. § 1.17(i) required)
- b. ☐ Other _____

3. Fees

The RCE fee under 37 C.F.R. § 1.17(e) is required by 37 C.F.R. § 1.114 when the RCE is filed.

- a. ☒ The Director is hereby authorized to charge the following fees, or credit any overpayments, to Deposit Account No. 19-5117
 - i. ☒ RCE fee required under 37 C.F.R. § 1.17(e) 01/23/2003 AWONDAF1 00000148 195117 09723718
 - ii. ☒ Extension of time fee (37 C.F.R. §§ 1.136 and 1.17) 01 FC:2801 375.00 CH
 - iii. ☒ Other Any deficiency in fees
- b. ☐ Check in the amount of \$ _____ enclosed
- c. ☐ Payment by credit card (Form PTO-2038 enclosed)

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

| | | | |
|-------------------|------------------|-----------------------------------|--------------|
| Name (Print/Type) | Barry J. Swanson | Registration No. (Attorney/Agent) | 33,215 |
| Signature | | Date | Jan 13, 2003 |

CERTIFICATE OF MAILING OR TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner For Patents, Box RCE, Washington, DC 20231, or facsimile transmitted to the U.S. Patent and Trademark Office on:

| | | | |
|-------------------|---------------|------|---------|
| Name (Print/Type) | Tasha L. Cove | Date | 1/13/03 |
| Signature | | | |

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Attorney Docket No. NEX10-6

#11
CW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: GOLD, ET AL.

SERIAL NO.: 09/723,718

FILED: NOVEMBER 28, 2000

TITLE: SYSTEMATIC EVOLUTION OF
LIGANDS BY EXPONENTIAL
ENRICHMENT: PHOTOSELECTION
OF NUCLEIC ACID LIGANDS AND
SOLUTION SELEX

EXAMINER: ZITOMER, S.

ART UNIT: 1655

CONFIRMATION NO.: 1084

Assistant Commissioner for Patents
Washington, D.C. 20231

REQUEST FOR CONTINUED EXAMINATION

Sir:

An Office Action was mailed in the above-captioned application on June 13, 2002. In such Office Action claims 11 and 12 were pending. Claims 11 and 12 were rejected. This Request for Continued Examination document is submitted in response to said Office Action.

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REMARKS

Request for Continued Examination

The last Office action was a final action. Applicant hereby requests continued examination of this application under 37 C.F.R. § 1.114(a).

The Double Patenting Rejections

The Examiner has rejected Claims 11 and 12 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of various patents. An obviousness-type double patenting rejection is appropriate when a claim merely defines an obvious variation of an invention claimed in a patent. M.P.E.P. § 804(II)(B)(1). A double-patenting rejection must rely on a comparison with the claims in an issued or to be issued patent. M.P.E.P. § 804(III).

37 CFR 1.8

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington D.C. 20231 on 1/13/03

Signature:

name:

Tasha L. Cove

The patents referred to in the rejections are U.S. Patent Nos. 5,705,337; 6,001,577; 5,998,142; 5,962,219; and 5,763,177. Enclosed herewith are terminal disclaimers with regard to U.S. Patent Nos. 6,001,577 and 5,763,177. Terminal disclaimers over the remaining patents are not being submitted as explained in detail below.

A. U.S. Patent No. 5,705,337. Specifically, the Examiner has rejected Claims 11-12 as being unpatentable over Claim 4 of U.S. Patent No. 5,705,337. The Examiner reasons that although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claim is drawn to a method in which nucleic acid ligands that bind covalently with a target molecule are identified wherein the candidate mixture nucleic acids in the method comprise photoreactive groups. The Examiner further reasons that it would have been obvious to the skilled practitioner in the art to provide the nucleic acid ligand identified by the recited method wherein such nucleic acid ligand comprises a photoreactive group which was known in the art to be able to crosslink a target molecule and where photoreactive groups including 5-bromouracil and 5-iodouracil were known in the art; and also that the skilled practitioner in the art would have been motivated by the known utility of nucleic acids in detection and purification of target molecules among other known benefits.

Applicant respectfully traverses this rejection. Claim 4 of the patent is drawn to a method for identifying nucleic acid ligands that bind covalently with a target molecule wherein the target is modified to include a chemical moiety that reacts with the chemically reactive functional unit of the nucleic acid. It is submitted that the use of a target molecule modified to include a chemical moiety that reacts with the chemically reactive functional unit of the nucleic acid to provide a nucleic acid ligand is a patently distinct feature of the cited claim, and as such, the double patenting rejection is improper.

B. U.S. Patent No. 5,998,142. The Examiner has also rejected Claims 11-12 as being unpatentable over claim 5 of U.S. Patent No. 5,998,142. The Examiner reasons that although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claim is drawn to a nucleic acid ligand which binds covalently with a protein (target molecule) wherein the nucleic acid ligand comprises a

chemically reactive functional unit defined in the patent as including photoreactive groups (column 10, lines 25-27) which include 5-iodouracil (column 29, Example 4).

Applicant respectfully traverses this rejection. Claim 5 of the patent claims a nucleic acid ligand which binds covalently with a protein, wherein said nucleic acid ligand comprises a chemically reactive functional unit. While this claim may contemplate 5-iodouracil as a chemically reactive functional unit, there are a number of photoreactive groups claimed in claim 12 which are not mentioned in the patent. It is submitted that mention of these additional photoreactive groups is a patently distinct feature of the cited claim, and as such, the double patenting rejection is improper. Reconsideration is respectfully requested.

C. U.S. Patent No. 5,962,219. The Examiner has also rejected Claims 11-12 as being unpatentable over claim 3 of U.S. Patent No. 5,962,219. The Examiner reasons that although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claim is drawn to a method in which nucleic acid ligands that bind covalently with a target molecule are identified wherein the candidate mixture nucleic acids in the method comprise photoreactive groups. The Examiner asserts that it would have been obvious to the skilled practitioner in the art to provide the nucleic acid ligand identified by the recited method wherein such nucleic acid ligand comprises a photoreactive group which was known in the art to be able to crosslink a target molecule and where photoreactive groups including 5-bromouracil and 5-iodouracil were known in the art. The Examiner further asserts that the skilled practitioner in the art would have been motivated by the known utility of nucleic acids in detection and purification of target molecules among other known benefits.

Applicant respectfully traverses this rejection. Claim 3 of the patent claims a method for identifying nucleic acids, wherein each nucleic acid has at least one nucleic acid region and at least one chemically reactive functional unit, including photoreactive groups. While this claim may contemplate 5-iodouracil and 5-bromouracil as chemically reactive functional units, there are a number of photoreactive groups claimed in claim 12 which are not mentioned in the patent. It is submitted that mention of these additional photoreactive groups is a patently distinct feature of the cited claim, and as such, the double patenting rejection is improper. Reconsideration is respectfully requested.

Closing Remarks

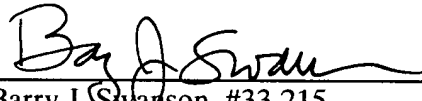
Applicant believes that the pending claims are in condition for allowance. If it would be helpful to obtain favorable consideration of this case, the Examiner is encouraged to call and discuss this case with the undersigned.

This constitutes a request for any needed extension of time and an authorization to charge all fees therefore to deposit account No. 19-5117, if not otherwise specifically requested. The undersigned hereby authorizes the charge of any fees created by the filing of this document or any deficiency of fees submitted herewith to be charged to deposit account No. 19-5117.

Respectfully submitted,

Date:

Jan 13, 2003



Barry J. Swanson, #33,215
Swanson & Bratschun, L.L.C.
1745 Shea Center Drive, Suite 330
Highlands Ranch, Colorado 80129
Telephone: (303) 268-0066
Facsimile: (303) 268-0065

cc: V. Appleby

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